

REMARKS

1 The Examiner rejected claims 1 and 4 under 35 U.S.C. § 102(b) as being
anticipated by Kater (5,046,509). Specifically, the Examiner incorrectly states that the
Kater device is provided with a "sleeve 112 that is slidably coupled to the outer surface
5 of the elongated tube" 100. Kater does not teach or otherwise disclose a sleeve or a
gasket that is slidably coupled with a tube. Rather, the Kater specification, at column 3,
lines 20-24, states that

the cylindrical seal 108 includes a central aperture 110 within which the
mounting end 104 of the needle 100 is fixedly attached. Furthermore,
the cylindrical seal 108 is fixedly attached to a needle receiving end 112
10 of the first connector member 106.

Clearly, the Kater device is provided with a needle or tube that is in a fixed, non-sliding
engagement with a seal, which is in a fixed, non-sliding engagement with the sleeve.
Applicant's device, however, clearly teaches and claims a sleeve and sealing gasket
that are slidably engaged with the outer surface of the tube in a manner that permits
15 selective, sliding movement of the sleeve and gasket along a length of the tube's outer
surface.

The Examiner further argues that he is "interpreting the claimed elements 'sleeve
that is slidably coupled' in this way: since the tube and gasket and sleeve are all
20 separate elements, the gasket must inherently be 'slidably mounted' along with the
sleeve on the tube." The Examiner then states that "according to Microsoft Bookshelf
Dictionary the definition of *coupled* is: two things connected together. Thus, 'attached'
can be considered synonymous as connected together." The Examiner's argument is
unclear and fails to address the issue of the relative movement enabled by the
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1 connection between the gasket and sleeve with the tube of applicant's invention. Claim
1 does not include a limitation that reads, in part, "sleeve that is slidably coupled."
However, in an effort to clarify the matter and expedite the prosecution of this matter,
claim 1 has been amended to specifically claim the structural and sliding engagement
5 between the components of the applicant's invention. Accordingly, claim 1 is believed
to be allowable, since a claim is anticipated only if each and every element as set forth
in the claim is found, either expressly or inherently described, in a single prior art
reference. Verdegaal, Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2
USPQ2d 1051, 1053 (Fed. Cir. 1987).

10 Claim 4 depends from claim 1 and is believed to be allowable for at least the
reasons set forth hereinabove with respect to claim 1. Applicant respectfully disagrees
with the Examiner's position that a taper in an end portion of a tube is the same as
angularly disposing the end of the tube with respect to the body of the tube. However,
15 Claim 4 has been amended to specifically state that the "tube is provided with an
angular bend, adjacent the distal end of said tube, so that the open interior portion of
said tube extends along a non-linear path between said proximal and distal ends." The
hollow interior portion of the needle disclosed by Kater is linear from one end to its
opposite end. Accordingly, claim 4 is believed to be allowable.

20 The Examiner rejected claim 8 under 35 U.S.C. § 102(b) as being anticipated by
Kramer et al. (4,969,870). The applicant respectfully disagrees with the rejection. The
Examiner states that Kramer et al. teach a device having a sleeve 19 that is slidably
coupled to the outer surface of the tube 15. However, the figures within the Kramer

1 reference clearly show that the tube 15 is attached in a fixed position within a handle 31,
which is slidably disposed within the sleeve 19. Accordingly, the sleeve is not slidably
coupled to the outer surface of the tube. If, for sake of argument the lower portion 43 of
the handle 31 were deemed to be the "tube", the reference still wouldn't read on the
claim due to the fixed engagement between the sleeve and the tube. Moreover, the
5 distal end of the tube in that situation would not be capable of being positioned within
the bone while the sealing surface was positioned outside the bone, as claimed within
claim 8, due to positive stop within the base 19. Applicant has amended claim 8,
however, to clarify the limitations previously set forth. The examiner is respectfully
10 requested to reconsider the aforementioned rejection and allow claim 8.

The Examiner has rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being
unpatentable over the Kater reference in view of Lee et al. (5,693,030). The Examiner
states that Kater fails to teach openings in the distal end of the tube or the use of an
15 obturator but that the Lee reference teaches such structures. Similarly, the Examiner
has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Kater in view
of Dubinsky (WO 99/52441). Specifically, the Examiner states that Kater fails to teach a
tube having an arcuate portion, as shown in Dubinsky. Applicant respectfully disagrees.
Claims 2, 3 and 5 depend from claim 1 and are believed to be allowable for at least the
20 reasons set forth hereinabove with respect to claim 1.

Moreover, in determining the difference between the prior art and the claims, the
question under 35 U.S.C. § 103 is not whether the differences themselves would have
been obvious, but whether the claimed invention as a whole would have been obvious.
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1 Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference and the claimed invention must be considered in their entireties.
Distilling an invention down the "gist" or "thrust" of an invention disregards the
requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.
5 v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.
851 (1984).

10 The mere fact that the references can be modified does not render the resulting
modified structure obvious unless the prior art also suggests the desirability of the
combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
statement that modifications of the prior art meet the claimed invention and would have
been 'well within the ordinary skill in the art at the time the claimed invention was made
because the references relied upon teach that all aspects of the claimed invention were
individually known in the art' is not sufficient to establish a *prima facie* case of
15 obviousness without some objective reason to combine the teachings of the
references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

20 Just because a structural detail is simple and known for other purposes, does not
render it "obvious". In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000), the
Federal Circuit Court of Appeals decided that the control of multiple valves by a single
sensor rather than by multiple sensors was a technologically simple concept. However,
the Federal Circuit held that there was no finding as to the specific understanding or
principal within the knowledge of the skilled artisan that would have provided the
25 motivation to use a single sensor as the system to control more than one valve. The

1 claimed structural design of applicant's device is an example of such a patentable
structure born from a technologically simple concept. More importantly, there is no
teaching or suggestion that would render the claimed combination of elements
"obvious". Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).
5 Accordingly, the combinations of claimed elements within claims 2, 3 and 5 are believed
to be patentable and the Examiner is respectfully requested to reconsider the
aforementioned rejections and to allow claims 2, 3 and 5.

10 In light of the above amendments and remarks, applicant asserts that the
claims are in condition for allowance. Applicant respectfully requests reconsideration
and allowance of the same.

No fees or extensions of time are believed to be due in connection with this
amendment; however, please consider this a request for any extension inadvertently
omitted, and charge any additional fees to Deposit Account No. 502093.

15 Respectfully submitted,



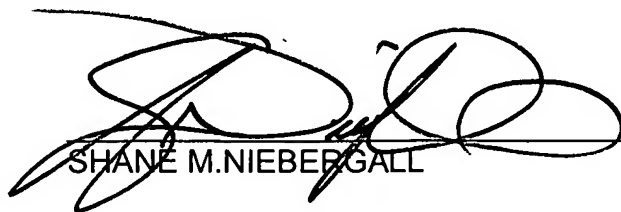
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CERTIFICATE OF MAILING

I hereby certify that the original of this SECOND AMENDMENT AFTER FINAL REJECTION for R. MICHAEL GROSS, Serial No. 10/046,592, was mailed by first class mail, postage prepaid, to Mail Stop RCE along with the RCE attached hereto, to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14th day of July, 2005.


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